

REMARKS

The indicated allowability of claims 1-18, mailed 8/28/2003, was withdrawn in view of the newly submitted JP 11-079260. Claims 1-4 and 9-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4,689,936) in view of JP 11-079260. Claims 5, 6, 14, 16 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4,689,936), and further in view of Muller et al. (US 4,404,241), and JP 11-079260. Claims 7 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4,689,936), and further in view of Lesser (US 5,012,061), and JP 11-079260. Claims 8 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4,689,936), and further in view of Inoue (US 4,769,175), and JP 11-079260.

1. Rejection over claims 1-4 and 9-13:

Claims 1-4 and 9-13 were rejected under 35 U.S.C. 103(a), for reasons of record that can be found on pages 3-5 of Paper No. 20, and also on pages 3-4 of the Office action identified above, which is Part of Paper No./Mail Date 030504.

The Examiner alleges that the present application was allowed based on the reasoning that the instantly claimed shapes of the port openings are unobvious. The Applicant submits that a material fact regarding the claimed invention as a whole has been pasted over. The shapes of the port openings are one subject that was discussed between the Examiner and the Applicant during the telephonic interview on 8/12/2003. The unobvious differences between the "gaps" of the present invention and the "port openings" taught in the prior art Gaikema et al. (US 4,689,936) and Challis et al. (US 5,672,406)

were also discussed during the interview on 8/12/2003. However, the Applicant submits that "the shapes of the port openings" should not be the only one patentable subject matter that renders the claims allowable. Furthermore, "the shapes of the
5 port openings" are not expressively mentioned in the independent claims 1 and 10 of the present application.

According to MPEP 2141, when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The
10 references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success
15 is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

According to MPEP 2142, to establish a prima facie case of obviousness, three basic criteria must be met. First, there
20 must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or
25 references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.
30 Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed

invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

10 The Examiner alleges that it is known art that various openings, including the ones in which the edges are in contact, can be used for increased gas permeability when the temperature increases, as taught by JP' 260, and it would have been obvious to one skilled in the art to modify Gaikema's vent openings
15 with various openings of JP' 260, motivated by the desire to accommodate various venting requirements. However, neither in JP' 260 nor in Gaikema's patent gives a motivation to combine the structures taught in respective prior art references. Besides, the combination proposed by the Examiner cannot reach
20 a reasonable expectation of success as indicated in the aforesaid MPEP 2142. That is, as recited in claim 1 of the present invention, "when the pressure difference between the two sides of the composite film increases, each of the gaps is enlarged by the air pressure exerted on one side of the
25 composite film and become air permeable, and restores again while the pressure difference is removed".

JP' 260 discloses a packaging material 1 having a base layer 2 and heat sealing layer 3 comprising an external breaking layer (also referred to as "outside fracture layer"), and an
30 internal opening port 4 with an end opened on an external face of the base layer 2 and the other end reaching at least the heat seal layer. The heat-sealing layer 3 is fracture and is

not air permeable until it is broken due to internal pressure buildup. After the fracture heat-sealing layer 3 ruptures, the packaging material 1 is permanently damaged and never restores again.

5 Gaikema et al. teaches a plastic cover 3 in the form of a covering plastic foil. The cover is provided with at least one pressure balancing opening or vent hole 5. During heat treatment, the pressure is balanced via the pressure balancing opening or vent hole. After the heat treatment, the pressure
10 balancing opening or vent hole must be hermetically sealed before bacteria or germs are able to penetrate into the package. The pressure balancing opening or vent hole is sealed by means of a meltable polymer compound or hot melt. The hot melt can be applied at the pressure balancing opening either before
15 or after the heat treatment. The hot melt may be in the form of a solidified drop sealing off the pressure balancing opening or vent hole. The hot melt may be provided with a perforation before the heat treatment. The hot melt may be in the form of a layer.

20 The Applicant believes that a *prima facie* case of obviousness cannot be established because both the prior art references fail to teach or suggest all the claim limitations. With reference to the accompanying figures 1-3, the Applicant tries to combine JP' 260 and Gaikema without considering
25 motivation of these two prior arts, and generates three possible combinations.

 In Fig.1, the resultant film structure 100 includes a plastic cover 3 in the form of a covering plastic foil, at least one pressure balancing opening 5, and a hot melt 7 (taught
30 by Gaikema et al.), in conjunction with an outside fracture layer 3' (taught by JP 11-079260). The film structure 100 is not equivalent to the composite film structure of the claimed

invention because the claimed invention does not need the outside fracture layer 3' that is not air permeable until it is broken. Besides, Gaikema's disclosure itself denies the combined film structure 100 because the outside fracture layer 3' (taught by JP 11-079260) inhibits the pressure balancing during heat treatment.

In Fig.2, the combined film structure 200 includes a base layer 2, an anchor layer 21, heat sealing layer 3' comprising an internal resin layer 31 and an external breaking layer 32, an internal opening port 4 with an end opened on an external face of the base layer 2 and the other end reaching external breaking layer 32 (taught by JP 11-079260), and a hot melt 7 (taught by Gaikema). In Fig.3, the combined film structure 300 includes a base layer 2, an anchor layer 21, heat sealing layer 3' comprising an internal resin layer 31 and an external breaking layer 32, and an internal opening port 4 with an end opened on an external face of the base layer 2 and the other end reaching external breaking layer 32. A hot melt 7 taught by Gaikema is in the form of a layer.

Neither the combined film structure 200 nor the combined film structure 300 is not equivalent to the composite film structure of the claimed invention because the claimed invention does not need the external breaking layer 32 that is not air permeable until it is broken.

The Applicant contends that the claimed invention is non-obvious over the cited prior art reference because the unique composite film structure as set forth in claim 1 and claim 10 is not taught in either of the prior art references. It is respectfully noted that none of the prior art references including newly submitted JP 11-079260 teaches that when a pressure difference between the two sides of the composite film is approximately zero (i.e., in an initial static state)

the gaps comprising two edges in contact with each other are closed, which is described in claims 1 and 10 of the present application. It is emphasized that, during such initial static state, the "gap" used in the independent claims 1 and 10 is
5 more like a break in continuity of the polymer composite film (see paragraph [0030] and also see Fig. 2A to Fig. 2C of the present application) rather than an opening, port, or stoma taught by the cited prior art references. All the cited prior art references teach an opening, port, port opening or stoma
10 that has no such characteristic (i.e., the gaps are closed and the edges are in contact with each other in the aforesaid initial static state).

Further, it is respectfully noted that the cited prior art references also fail to disclose the important limitation as
15 set forth in claims 1 and 10 of the present application: when the pressure difference is removed, each of the gaps, which was opened (or enlarged) when the pressure difference between the two sides of the composite film increases, reversibly restores again to its initial status, i.e., each of the gaps
20 is closed again with two edges thereof in contact to each other.

To sustain a 103 rejection, all claim limitations must be found or expressly taught in the prior art. Referring to Fig. 1, Fig. 3 and Abstract of the submitted JP 11-079260, which discloses a packaging material 1 having a base layer 2 and
25 heat sealing layer 3 comprising an external breaking layer (also referred to as "outside fracture layer"), and an internal opening port 4 with an end opened on an external face of the base layer 2 and the other end reaching at least the heat seal layer. It is respectfully noted that the internal opening port
30 4 has been opened already in its initial status. It is further respectfully noted that the heat-sealing layer 3 is fracture and is not air permeable until it is broken due to internal

pressure buildup. That is, the internal pressure is not released from the opening port 4 until the heat-sealing layer 3 ruptures. Upon rupture of the fracture heat-sealing layer 3 occurs, there is no chance for the packaging material 1 to
5 restore again to its initial status. This is not the case as the claimed invention of the present application. The present invention does not need this fracture heat-sealing layer 3. The heat-sealing layer 3 that is not air permeable until it is broken is not equivalent to the nonstick sealing layer as
10 set forth in the present application.

In light of the above, the Applicant suggests that claims 1 and 10 are now in condition for allowance. Since claims 2-4, 9, and claims 11-13 are dependent on respective claims 1 and 10, they should be allowed if claims 1 and 10 are allowed.
15 Reconsideration of claims 1-4 and 9-13 is therefore politely requested.

2. Rejection over claims 5-8 and 14-18:

Since claims 5-8 and 14-18 are dependent on respective
20 claims 1 and 10, they should be allowed if claims 1 and 10 are allowed.

3. The IDS (Information Disclosure Statement) enclosed with JP 11-079260 was submitted in compliance with 37 CFR 1.97 on
25 8/11/2003, two days before the telephonic interview (8/13/2003). The Examiner states that the Applicant failed to bring the newly filed IDS to the Examiner's attention during the interview on 8/13/2003.

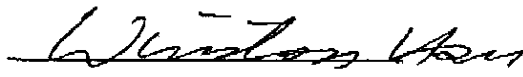
The Applicant's explanation is listed below. First, when
30 submitting the IDS, the Applicant didn't deem JP 11-079260 a 103 prior art since the aforesaid limitations of the claimed invention are not taught in JP 11-079260. Second, the subjects

under discussion had been set before the date of the interview
and also before the date of the submission of the IDS. Further,
the Applicant didn't know that when will the IDS document be
received by the Examiner because USPTO's internal operation
5 speed is always very difficult to predict. The Applicant thus
believes that there is no need to mention the IDS in the
interview because the Examiner will receive and consider it
anyway.

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Sincerely yours,

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